

Serial No. 10/728,879

Attorney Docket No. 113708.127 US2

**REMARKS**

Claims 14-23 and 26-31 are pending. Claims 24-25 have been canceled. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 14-31 were rejected under 35 USC 101, as being directed to non-statutory subject matter. The office action suggested corrections with respect to independent claims 14 and 23 to remedy the deficiencies. By way of the above amendment, the examiner's suggestions are adopted. Therefore, the examiner is respectfully requested to reconsider and withdraw the rejection.

Claims 14-16, 18-20, 23-26 and 28-30 were rejected under 35 USC 102(e) as being anticipated by U.S. Patent Publication No. 2004/0024739, Copperman et al. ("Copperman"). Dependent claims 17, 21-22 and 31 were rejected under 35 USC 103(a) as being unpatentable over Copperman in view of U.S. Patent Publication No. 2004/0230574, Kravets ("Kravets"). Dependent claim 31 was rejected under 35 USC 103(a) as being unpatentable over Copperman and Kravets, further in view of U.S. Patent No. 5,991,751, Rivette et al. ("Rivette").

Independent claim 14 has been amended to incorporate subject matter located in original claim 18. Independent claim 23 is amended to incorporate subject matter located in original claims 24-25. Further support for amended claims 14 and 23 is located in the specification as filed, for example, paragraph [0037]-[0039] and [0041]-[0043]. Insofar as the rejections can be applied to the claims as amended, the applicant respectfully requests that these rejections be withdrawn for reasons including the following, which are provided by way of example.

The application describes "the laborious tasks of search for, retrieving, analyzing, and organizing various forms of IP." (Paragraph [0002].) The application recognizes that known

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electronic searching systems "are unable to facilitate or automate the creation of search queries and criteria." (Paragraph [0004].)

Independent claim 14 recites in combination, for example,

designating a field of search including selection of at least one of a plurality of classifications of an intellectual property classification system, wherein the field of search includes plural intellectual property documents; (b) generating a list of words found in the content of the plural intellectual property documents ...; (c) entering search criteria utilizing keywords that formulate a search query, wherein the keywords can be different from the words in the list of words; (d) determining searchable elements related to select keywords in the search criteria of step (c) by locating words in the list of words generated in said generating step (b) that are synonyms of the selected keywords; and (e) executing the search query to search the content of the intellectual property documents using the select keywords and the synonyms...

(See also independent claim 23.) Thereby, a search query can be formulated by entering keywords (which can be different from the words in the list of words), where the search is conducted using the selected keywords and synonyms of the keywords which are in the list of words. Because the keyword synonyms are selected from the documents in the classification, the search can avoid the problem where a synonym is inappropriate or missing for the particular classification.

Without conceding that Copperman discloses any feature of the present invention, Copperman is directed to a knowledge management system. According to Copperman, a particular document is converted into a structured record, terms are extracted from a particular document and evaluated for inclusion in a taxonomy, and the converted document is marked up with taxonomy tags (FIG. 5). Knowledge containers that refer to the converted documents are organized through use of taxonomies (FIG. 1).

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The office action asserts that Copperman discloses the invention as claimed. To the contrary, Copperman fails to teach or suggest the invention, as presently claimed, when the claims are considered as a whole.

Copperman fails to teach or suggest, for example, "generating a list of words found in the content of the plural intellectual property documents." (See, e.g., claims 14, 23.) To the contrary, Copperman is concerned with properly categorizing each document by its own contents, so that each document can be converted. Thus Copperman does not and cannot use the list of words from plural documents that are in the classification. The office action cites paragraphs [0008] and [0075] as being particularly relevant, where paragraph [0075] discusses the detail of spotting technical terms in the content of a particular document, with reference to FIG. 5 illustrating the conversion of a document into Copperman's standard format. Each converted document is inserted with taxonomy tags appropriate to the document's content, and can indicate "exactly the portion of the knowledge container that is most relevant to their question." (E.g., paragraph [0082]-[0083].) Copperman, however, fails to teach or suggest generating a list of words found in the content of plural documents in the designated field of search. To the contrary, Copperman aims to mark each individual document with its own taxonomy based on its own content. It follows that Copperman fails to teach or suggest generating a list of words located in the content of multiple documents.

Copperman fails to teach or suggest, as another example, "determining searchable elements ... by locating words in the list of words ... that are synonyms of the select keywords." (E.g., claims 14, 23.) The office action contends that the augmentation or expansion of a query discussed in Copperman, paragraph [0162], lines 1-6 teaches this. Paragraph [0162] states that "query expansion may be based upon a thesaurus, to include synonyms or other related terms in the text." This is the only mention of a thesaurus in Copperman. Copperman, paragraph [0162]

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discusses autocontextualization including topic taxonomy tag identification. However, Copperman's taxonomy tags are in Copperman's converted documents (e.g., FIG. 5), not in the "the list of words" found in the plural intellectual property documents. Copperman simply fails to teach or suggest the combination of locating words in the list of words which are synonyms of the keywords selected for the search criteria, and using those synonyms as search criteria, where the synonyms are located in the list of words which is "found in the content of the plural ... documents."

Copperman fails to teach or suggest, for example, these elements recited in independent claims 14 and 23. It is respectfully submitted therefore that claims 14 and 23 are patentable over Copperman.

The office action cites Kravets and/or Rivette as remedying the defects of Copperman. For example, the office action admits that Copperman does not "explicitly disclose wherein said displaying step (e) comprises simultaneous display of the search criteria during operation of said entering step (c)." Kravets is cited as remedying this deficiency. Also, the office action admits that "Copperman does not explicitly disclose wherein the classification system is the system used by the U.S. Patent and Trademark Office for classification of patents, and wherein the input signals contain a selection of a plurality of classes and subclasses that form the source grouping." Rivette is cited as teaching the input signals of the U.S. Patent and Trademark Office classification of patents. However, Kravets and/or Rivette, alone or in combination, fail to remedy the deficiencies discussed previously.

For at least these reasons, the combination of features recited in independent claims 14 and 23, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In

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addition, Copperman and the other references of record fail to show other recited elements as well.

With respect to the rejected dependent claims, the applicant respectfully submits that these claims are allowable not only by virtue of their dependency from allowable independent claims 14 and 23, but also because of additional features they recite in combination.

The applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, the applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples the applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

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If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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